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Roy N Envall, Jr
c/o Anthony Castorina
2001 Jefferson Davis Highway Suite 207
Arlington, VA 22202

EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,987

Applicant(s)

KOPPEL ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38, 40-44, 46, 47 and 57-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-38, 40-44, 46 and 47 is/are allowed.
- 6) ☒ Claim(s) 57-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Action Background

1. This action is responsive to the amendment, filed on 10/3/2005.
2. In the office action dated 12/7/2004, claims 1-38, 40-44, 46, 47, 57 and 58 were allowed.
3. In the amendment of 10/3/2005, the applicant has added claims 63-65.
4. Claims 1-38, 40-44, 46, 47 and 57-65 are pending in the case, claims 1, 8, 9, 24, 46, 59, 60 and 61 are independent claims.
5. The prosecution of existing claims 59-62 and new claims 63-65 is the subject matter of this office action.
6. Applicant's arguments, see page 14, third paragraph, filed 10/3/2005, with respect to the rejection(s) of claim(s) 59-62 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made, as described below.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

8. Claims 59-62 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. **Regarding Claims 59-62**, the claimed invention is so abstract and sweeping as to cover the method if practiced by a human operator assisted only by pencil and paper. Claims 59-62 do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process", is not patentable subject matter.

"Phenomena of nature, though just discovered, *"mental processes"*, abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (Emphasis added). *Gottschalk v. Benson*, 175 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing*, 162 U.S.P.Q. 571 (1969).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

11. Claims 59-62 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. **Regarding claim 59**, the amendment filed 3/7/2005 adds the following limitations: *"generating documents based on a search query"* (preamble), *"obtaining an initial set of documents relevant to the search query"* (first limitation), *"assigning relevance scores to the documents based on cross references between the documents within the initial set"* (second limitation), and *"sorting the documents based on the assigned relevance scores"* (third limitation). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

13. **Regarding claim 60**, the amendment filed 3/7/2005 adds the following limitations: *"responding to a search query from a user"* (preamble), *"receiving*

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the search query from the user (first limitation), *"generating a list of relevant documents based on search terms of the query"* (second limitation), *"generating relevance scores for the documents in the list of relevant documents based on cross references between the documents in the list"* (third limitation) and *"returning a set of relevant documents to the user, the set being sorted based on the relevance scores"* (fourth limitation). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

14. **Regarding claim 61**, the amendment filed 3/7/2005 adds the following limitations: *"providing search results"* (preamble), *"generating a limited list of results indexed to said search term"* (second limitation), *"generating a limited set of pages including links to said limited list and indexed to said search term"* (third limitation) and *"generating a set of search results responsive to the number of links from said limited set to pages in said limited list."* (fourth limitation). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

15. **Regarding claim 62**, the amendment filed 3/7/2005 adds the following limitation: *"generating a limited set of pages comprises selecting pages including said search term"*. The examiner has reviewed the originally filed

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specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

16. In the response filed 10/3/2005 the applicant has directed the examiner to various portions of the specification in support of the subject matter for claims 59-61. The examiner has reviewed the portions of the specification indicated, but fails to find the indicated portion of the specification to support the claim subject matter. A more detailed response is provided in the *Response to Arguments* section of this office action (below).

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

18. Claims 59-62⁵ are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan et al., US Patent 6,421,675 (filed 7/15/1998, patented 7/16/2002).
"Ryan et al." is hereafter referred to as "Ryan".

19. In regard to independent claim 59, Ryan discloses generating documents based on a search query. Ryan recites: *"The present invention relates to a method and apparatus that allows for enhanced database searching, and more particularly; for use as an internet search engine"* (column 1, lines 8-10) and *"The results of this search are then displayed to the user, as shown by steps of displaying a created list of web pages"* (column 4, lines 36-38). Ryan discloses obtaining an initial set of documents relevant to the search query. Ryan recites: *"the URL address of the web page or pages that they wish to submit"* (column 5, lines 36-37). Ryan discloses

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assigning relevance scores to the documents based on the cross references between the documents within the initial set and sorting the documents based on the relevance scores. Ryan recites: *"Hit-list: The list of web-pages URL addresses that is the result of the key-word search. This hit-list ranks the relevance of the web-pages"* (column 6, lines 12-14).

20. **In regard to independent claim 60**, Ryan discloses responding to a search query, obtaining an initial set of documents relevant to the search query and assigning relevance scores to the documents based on the cross references between the documents within the initial set and sorting the documents based on the relevance scores as described in the previous paragraph. Ryan further discloses receiving a search query from a user. Ryan recites: *"The search engine receives the search command, and then using it scans for these key words through a database of web addresses and the text stored on the web sites"* (column 1, lines 25-28).

21. **In regard to independent claim 61**, Ryan discloses providing search results in response to a provided search term, and generating a limited list of results indexed to the search term as described in the previous paragraphs. Ryan discloses generating a limited set of pages including links to the limited list and indexed to the search term. And generating a set of search results responsive to the number of links from the limited set of pages in the limited list. Ryan recites: *"In an attempt to index the information available on the internet, a number of software search engines have been created via which a*

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user enters a search command" (column 1, lines 19-22) and *"The search engine receives the search command, and then using it scans for these key words through a database of web addresses and the text stored on the web sites"* (column 1, lines 25-28).

22. **In regard to dependent claim 62**, Ryan discloses selecting pages including the search term. Ryan recites: *"The user typically makes a selection from the list"* (column 1, line 56).

23. **Regarding claims 63-65**, the claims are directed toward a computer-implemented method for the method of claims 59-61, respectively, and are rejected using the same rationale.

Allowable Subject Matter

24. Claims 1-38, 40-44, 46, 47, 57 and 58 are allowed, as described in the *Reasons For Allowance* section of the office action dated 12/7/2004.

Response to Arguments

25. Applicant's arguments with respect to the rejection of claims 59-62, made under 35 USC 102(b) have been considered, but are moot in view of the new ground(s) of rejection as described above.
26. Applicant's arguments filed 10/3/2005 with respect to the rejection of claims 59-62 made under 35 USC 101 and 35 USC 112 have been fully considered but they are not persuasive.
27. **Regarding claims 59-62**, with respect to the rejection made under 35 USC 101, applicant argues that "*a computer related process is considered statutory*" (page 11, third paragraph of the response filed 10/3/2005). Applicant is directed to the rejection, as restated above. Claims 59-62 fail to recite a particular machine or apparatus.
28. **Regarding claims 59-62**, with respect to the rejection made under 35 USC 112, applicant provides an explanation of "*the interrelationship between 'site' and 'document'*" (page 12, third paragraph of the response filed 10/3/2005). The examiner agrees with the applicant that within the context of the electronic document arts, that "*site*", "*page*" and "*document*" have interchangeable meaning. However, because the claims fail to recite a particular machine or apparatus, the scope of the claims fails to be restricted to an electronic document related art. Therefore the terms "*document*", "*search query*" and "*search result*" are given the broadest possible meaning.

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29. **Regarding claims 59-62**, with respect to the rejection made under 35 USC 112, applicant has directed the examiner to specific portions of the specification in support of the claims. The examiner has reviewed the portion of the specification indicated, but fails to find the indicated portion of the specification as supportive of the claim subject matter.

30. **Regarding claim 59**, the claim recites: *"generating documents based upon a search query"* (claim preamble). Applicant indicates that page 9, lines 16-17, support this limitation. The indicated passage is directed toward analyzing search results to assist a user in finding sites or hubs. The examiner contends that *"finding sites"* is not the same as *"generating documents"*.

Claim 59 further recites: *"obtaining an initial set of documents relevant to a search query"* (first limitation). Applicant indicates that page 9, line 31 to page 10, line 5 support this limitation. The indicated passage is directed toward *"locating a plurality of sites"*, *"the listing of links"*, *"providing link lists"*, *"optional filtering steps"* and *"other possible filtering rules"*. The examiner contends that *"locating sites, a list of links"* and *"filtering"* are not the same as *"obtaining a set of documents"*.

Claim 59 further recites: *"assigning relevance scores to the documents"* (second limitation). Applicant indicates that page 10, line 6-26 support this limitation. The indicated passage is directed toward ranking of search results and groups of sites. The examiner contends that *"document relevance scores"* are not the same as *"search result ranking"* or *"site group ranking"*.

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Claim 59 further recites: "*sorting the documents based on the assigned relevance scores*" (third limitation). Applicant indicates that page 10, line 22 to page 11, line 7 support this limitation. The indicated passage is directed toward "*collating and ranking search results*" and "*filtering sites*". The examiner contends that "*collating and ranking search results*" and "*filtering sites*" are not the same as "*sorting documents*".

31. **Regarding claim 60**, the claim recites "*responding to a search query from a user*" and "*receiving a search query from the user*" (claim preamble and first limitation). Applicant indicates that page 9, line 29 to page 12, line 20 support this limitation. The indicated passage is directed toward "*Finding Hubs*", and a "*keyword search*" is specifically mentioned, however, the specification fails to describe the user performing the search. In fact the user is not mentioned until page 11, line 8 wherein the specification recites: "*The filtered hubs are presented to the user*". The specification fails to support the "*from the user*" aspect of the limitations. The balance of claim 60 limitations are similarly not supported by the specified passages.

32. **Regarding claim 61**, the claim recites: "*providing search results*" (claim preamble). Applicant indicates that page 11, line 8, line 20 support this limitation. The indicated passage is directed toward "*filtered hubs are then presented to user*". The examiner contends that "*filtered hubs are then presented to user*" are not the same as "*providing search results*".

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Claim 61 further recites: "*list of results indexed to said search term*" (second limitation). Applicant indicates that page 9, line 31 to page 10 line 5 support this limitation. The indicated passage is directed toward "*locating a plurality of sites*", "*the listing of links*", "*providing link lists*", "*optional filtering steps*" and "*other possible filtering rules*". The examiner contends that "*locating sites, a list of links*" and "*filtering*" are not the same as "*results indexed to said search term*". The balance of claim 61 limitations are similarly not supported by the specified passages.

Conclusion


33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
May 24, 2005



STEPHEN HONG
SUPERVISORY PATENT EXAMINER